



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,893	09/29/2003	Mohammad Hossein Zarrabizadeh	24	1988
22046 7590 02/12/2009 Docket Administrator - Room 2F-192 Alcatel-Lucent USA Inc. 600-700 Mountain Avenue Murray Hill, NJ 07974				
EXAMINER AZARIAN, SEYED H				
ART UNIT		PAPER NUMBER		
2624				
MAIL DATE		DELIVERY MODE		
02/12/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/673,893

Applicant(s)ZARRABIZADEH, MOHAMMAD
HOSSEIN**Examiner**

Seyed Azarian

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-25, 27, 29, 32 and 34 is/are allowed.
- 6) ☒ Claim(s) 1-21, 26, 28, 30, 31 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/29/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

1. Applicant's arguments, filed 11/5/2008, see page 1 through page 27 of the remarks, with respect to the rejection of claims 1-5, 7-14, 16, 17, 20-22, 24-25 and 28-30 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, due to the newly developed interim guidelines for 35 USC 101, (In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008)) regarding process claims, claims 1-21, 26, 28, 30, 31 and 33 are rejected. Also in brief telephone interview with applicant representative Examiner suggested ways to clarify the independent claim that may overcome the rejection of 35 USC 101, but agreement was not reached.

Claim Rejections - 35 USC § 101

2. Claims 1-21, 26, 28, 30, 31 and 33 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. The Federal Circuit, relying upon Supreme Court precedent, has indicated that a statutory "process" under 35 U.S.C. 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This is referred to as the "machine or transformation test", whereby the recitation of a particular machine or transformation of an article must be impose meaningful limits on the claim's scope to impart patent-eligibility (See Benson, 409 U.S. at 71-72), and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See Flook, 437 U.S. at 590"). For example "automatically selecting a

chrominance portion of a pixel of an image of a video signal to be watermarked". While the claims recite a series of steps or acts to be performed, the instant claims neither transform underlying subject matter nor positively tie to particular machine that accomplishes the claimed method steps. In order for process to be "tied" to a particular machine, the structure of a particular machine should be positively recited in a step or steps significant to the basic inventive concept, and not just in association with statements of intended use or purpose, insignificant per or post solution activity, or implicitly. Appropriate correction is required. In re Bilski 88 USPQ2d 1385 (Fed. Cir. 2008).

REASONS FOR ALLABLE CLAIMS

3. The reasons for allowable claims, set fort in the previous office action dated on 11/14/2007 are not repeated herein, but are incorporated by reference. As applicants properly point out in the previous remark, the prior art fails to disclose the claim limitation.

Contact Information

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seyed Azarian whose telephone number is (571) 272-7443. The examiner can normally be reached on Monday through Thursday from 6:00 a.m. to 7:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehta Bhavesh, can be reached at (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

Status information about the PAIR system, see [http:// pair-direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Seyed Azarian/
Primary Examiner, Art Unit 2624
Group Art Unit 2624
February 10, 2009*